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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2164

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/047,666	Applicant(s) BARRETT ET AL.	
	Examiner Sam Rimell	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



**SAM RIMELL
PRIMARY EXAMINER**

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Preliminary Note: This office action includes a new grounds of rejection under 35 USC 101, not necessitated by amendment. Accordingly, this office action is made non-final.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 6-27 are rejected under 35 U.S.C. 101 because the claimed invention is non-statutory.

Claim 1: Claim 1 is addressed to a method of generating a popularity score. A popularity score (i.e a number or value) is not considered to be a tangible result under the requirements for tangible results defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998). It should be particularly noted that while a “computer implemented method” does recite the presence of a computer, which is tangible, it is the result which must be tangible according to *State Street*. A “popularity score” is only a number or value and is not a tangible result, even if a computer is used to generate it.

MPEP 2106 Section II A states:

“The claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result” (emphasis added). State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research.”

Claim 6: Claim 6 is addressed to a database containing an enhanced popularity score. Neither the database (which is only a set of records) nor the popularity score (a number or value) are considered to be tangible results under the requirements of *State Street* (cited herein).

Claims 7-8: Depend on claim 6.

Claim 9: Claim 9 is addressed to a method of generating a use history and generating a popularity score. Neither the use history (a listing of information) nor the popularity score (a number or value) is a tangible result under the requirements of *State Street* (cited herein).

Claims 10-14: Depend on claim 9.

Claim 15: Claim calls for the development of hypothetical enhanced popularity scores and an enhanced popularity score. Neither type of score meet the requirement for a tangible result under *State Street*.

Claim 16-19: Depend on claim 15.

Claim 20: Claim 20 is addressed to the method of applying a time and a date code to a website and accounting for the website in a score. A website is not tangible unless it is embodied as part of a graphical user interface and a score is not tangible for the reasons previously recited herein. The features of the claim do not meet the requirement for a tangible result as defined by *State Street*.

Claim 21: Depends on claim 20.

Claim 22: Claim 22 is directed to a system that is composed only of code. Code itself is not considered to be tangible unless it is embodied on a tangible medium. Since there is no tangible medium being claimed, the code itself is not tangible as required by *State Street*. Additionally, the claim fails to meet the requirement for a useful result, since the code is not

characterized as being executable by a computer to produce some result. In other words, the code is merely a set of generic instructions, and there is no indication that code is configured to be executed on a computer to produce the desired result.

Claim 23: Depends on claim 22.

Claim 24: Claim 24 is addressed to a system that is composed of a memory and program. Since the program is not associated with any memory structure, particularly, a tangible memory substrate, the claimed invention lacks any tangible result. Additionally, the claimed invention lacks the requirement for a useful result, since the program is not claimed as being executable by a computer to produce the result.

Claims 25-27: Depend on claim 24.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 9: Claim 9 has been amended to define a “modified use history” and the generation of a popularity score based on this use history. The original specification makes no mention of a “use history” nor of a “modified use history”. There is also no discussion in the original specification of basing a popularity score on such a use history. Accordingly, the

features of a: (1) use history; (2) modified use history; and (3) popularity score based on the modified use history, are each new matter.

Claims 10-14: Depend on claim 9.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-8 and 15-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Edlund et al. (U.S. Patent 6,546,388).

Claim 1: Col. 8, line 40-62 describe the performance of a search query. The query produces search results. The search results are weighted using a calculated relevancy score (col. 10, lines 60-63, describing steps 5-6). The score is based on popularity counts as an inflation factor. As described at col. 9, lines 45-50, the popularity count is only incremented for the newest version of a website (version 0), which means that the popularity count weighs the newest version more heavily than any previous versions. The relevancy score thus becomes an enhanced score based on popularity (an enhanced popularity score).

Claim 3: The ranking scheme disclosed Edlund et al. involves taking a search result (based on a submitted search request) and a relevancy score and weighting the search results based on the relevancy score. As described at col. 9, lines 45-50, the popularity count is the basis of the relevancy score and the popularity count is only incremented for the newest version (version 0) of a website. This means that the popularity count weighs the newest version more

heavily than any other version. The relevancy score thus becomes an enhanced score based on popularity (an enhanced popularity score).

Claim 4: The popularity counts described at col. 9, lines 36-42 form a weighting value for each search result. This weighting value is an inflation score. The inflation score is adaptive in that it can constantly change (the popularity counts change as the website receives more hits).

Claim 5: The overall rank applied to the search results is a blend of three factors: (1) content relevance value (2) popularity; and (3) document recency.

Claim 6: The table illustrated in col. 9, lines 36-42 is a database. It is a relational database having rows related to columns. The popularity score is shown in the far right column. The score is enhanced by the inclusion of version numbers. The URLs are the information that is indexed in the database. The popularity counts are the claimed popularity scores. As described at col. 9, lines 45-50, the popularity count is only incremented for the newest version of a website (version 0). This means that the popularity count weights the newest version more heavily than any other previous version.

Claim 7: The information in the database of col. 9, lines 36-42 are URLs derived from the Internet.

Claim 8: Each URL is a discrete piece of data that is wholly contained with the database table of col. 9, lines 36-42.

Claim 15: The popularity counts (number of hits over time) are the time decay rates. As seen in the table of col. 9, lines 35-42, there are highest and lowest decay rates (highest and lowest popularity counts). The enhanced popularity scores are the calculated relevancy values based on the popularity counts (col. 10, lines 60-61). The use history is the complete table at col.

9, lines 35-42. The enhanced popularity scores can be calculated for each search query, which means that there can be two or more such scores. The popularity counts are the time decay rates and are incremented only for the newest version of a web site (col. 9, lines 45-50). If no additional websites appear, this count will increase over time and exceed the counts for previous versions.

Claim 16: The weighting factor is popularity count, which is a rate of use of certain URLs during the time period of measurement.

Claim 17: See remarks for claim 11.

Claim 18: Popularity counts correlate to website traffic.

Claim 19: The popularity counts are calculated by the computer system incrementing a counter. A calculation is readable as an estimate, lacking any further details on how the estimate is made or what kind of estimate is made.

Claim 20: Col. 8, lines 66-67 calls for the retrieval data from documents and the calculation of the documents age. The only manner in which such a calculation could be performed is if the document was time and date stamped and the calculation of document age determined from the time and date stamp. The age of the document is input to a relevancy calculator (col. 9, lines 1-2) which calculates a relevancy score (col. 10, lines 60-61). This score reads as the claimed enhanced “population” score. The enhanced “population” score also considers popularity counts that are only incremented on the newest version of a website (col. 9, lines 45-50). As a result, the popularity count used to form the enhanced “population” score weighs more heavily on the newest version of a website than on any previous version.

Claim 21: The age of the document is calculated (col. 8, lines 66-67).

Claim 22: See remarks for claims 20 and 21.

Claim 23: Claim 23 is directed to the intended usage of the code in allowing a user to perform certain actions. It does not define the content of the code and is thus a recitation of intended usage which carries no patentable weight (MPEP 2106, Section C, Example A).

Claim 24: FIG. 2 illustrates a memory (0208) for storing information related to user queries. The information is ranking information derived from the results of the queries. Col. 10, lines 50-68 illustrates a computer controlled algorithm that creates a popularity score (calculated relevance value—step 5) in response to a request. The score is modified by factors such as version recency and popularity counts (step 5). Since the popularity count used to generate the score increments only the most recent websites (col. 9, lines 35-42 and lines 45-50), the popularity count weighs more heavily the newest websites.

Claim 25: The information (search results) may include links to websites (URLs—col. 9, lines 36-42).

Claim 26: The system described at col. 8, line 55 through col. 9, line 6 describe weighting factors that can ultimately modify the final score. These factors are described at col. 8, lines 61-62) are invoked when search results are received.

Claim 27: See col. 8, lines 66-67.

Remarks

This office action includes new grounds of rejection under 35 USC 101 which are not necessitated by amendment. Accordingly, this action is made non-final.

Art Unit: 2175

Applicant's amendments have overcome the previously applied rejections under 35 USC 112, second paragraph.

Applicant's amendments to claim 9 have raised new grounds of rejection under 35 USC 112, first paragraph. The basis for this rejection is set forth in greater detail in the discussion of claim 9.

Claims 1, 3-8 and 15-27 remain rejected under 35 USC 102(e) as being anticipated by Edlund et al.

Applicant asserts that Edlund et al. is not prior art, and asserts a "right" to swear behind the reference "at a later date". Examiner maintains that Edlund et al. is in fact prior art as defined under the requirements of 35 USC 102(e). If applicant intends to prove otherwise by providing evidence which swears behind the reference, then such evidence should be made of record for consideration in response to this office action.

Applicant's arguments regarding the Edlund et al. reference are that Edlund et al. does not weight a recent click more heavily than an older click for the same information. This argument is understood, but is essentially moot since none of the claims are addressed to concept of considering the recency of the clicks themselves. The claims are broader in scope than the arguments which are presented.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell
Primary Examiner
Art Unit 2164